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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,158	12/08/2003	Takeshi Makiyama	1152-0293P	3080

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EXAMINER

SHERALI, ISHRAT I

ART UNIT PAPER NUMBER

2621

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/729,158		MAKIYAMA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Sherali Ishrat		2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20 and 22 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/727,787.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 20 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 20 of copending application no. 10/728866. Although the conflicting claims are not identical, they are not patentably distinct from each other.

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Regarding claim 20 of instant application and claim 20 of copending application no. 10/728866, claims recite:

storage device for storing a coding algorithm for coding image data and the tools constituting algorithm (claim 20 of instant application, lines 2-3) which is same as storing previously defined tools and coding the image data using the stored coding algorithm (claim 20 of copending application no. 10/728866, line 2 and lines 5-6);

an encoder for inputting image data and coding the image data using stored coding algorithm (claim 20 of instant application, lines 5-6) which is same as inputting image data and coding the image data using stored coding algorithm (claim 20 of copending application no. 10/728866, lines 5-6);

an output device outputting coded image data with tool information indicating the decoding algorithm for decoding the coded image data (claim 20 of instant application, lines 6-7) which is same as transmitting coded image data and tool information indicating the decoding algorithm for decoding the coded image data (claim 20 of co-pending application, lines 7-8, it is obvious that coded image data with tool information is outputted to decoder by transmission),

at least one tool for constituting the decoding algorithm is selected individually (claim 20 of instant application, lines 9-10) which is same as individually selecting at least one tool from the stored tools (claim 20 of copending application, lines 3-4).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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3. Claims 20 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,310,981 in view of Yagizawa et al. (JP Kokai Patent Application No. Hei 4 [1992]-8064).

Regarding claims 20 of instant application and claim 4 of U.S Patent 6,310,981, claims recite:

storing a coding algorithm and tools constituting the algorithm (claim 20 of instant application, lines 2-3) which is same storing a coding algorithm and tools constituting the algorithm (U.S Patent 6,310,981, claim 4, lines 2-3)

an encoder for inputting the image data and coding the image data using the stored coding (claim 20 of instant application, lines 3-4) which is same as an encoder for inputting the image data and coding the image data using the stored coding algorithm (U.S Patent 6,310,981, claim 4, lines 8-9);

outputting coded image along with information indicating decoding algorithm (claim 20 of instant application, lines 5-6) which is same as outputting coded image along with information indicating decoding algorithm (U.S Patent 6,310,981, claim 4, lines 10-11);

one tool from the previously stored tools constituting decoding algorithm is selected (claim 20 of instant application, line 12) which is same as tools from N+1 ranked layer perform decoding with lower image quality as a substitute of N ranked i.e N+1 is selected for decoding (U.S Patent 6,310,981, claim 4, lines 8-9),

U.S. Patent No. 6,310,981 shows selecting multiple tools (U.S. Patent No. 6,310,981, claim 4, lines 4-5, tools for N+1 ranked layer perform decoding). U.S. Patent No. 6,310,981 however have not shown individually selecting at least one tool from the stored tools.

In the same field of endeavor Yagizawa discloses individually selecting at least one tool from the stored tools (Yagizawa in page 5, lines 9-10 and page 5, lines 27-28, states "A coding algorithm storage means configured with multiple RAMS for storing coding table containing coding algorithm for DPCM" and "DPCM table is loaded, can be selected by switching a switch" which corresponds to individually selecting at least one tool from the stored tools).

Regarding claims 22 of instant application and claim 4 of U.S Patent 6,310,981, claims recite:

inputting image data (claim 22 of instant application, line 2) which is same as inputting the image data (U.S Patent 6,310,981, claim 4, line 8);

storing previously defined tools (claim 22 of instant application, line 3) which is same as storing multiple tools (U.S Patent 6,310,981, claim 4, line 3);

selecting at least one tool from the previously stored tools (claim 22 of instant application, line 4) which is same as encoding the image data using stored coding algorithm (U.S Patent 6,310,981, claim 4, lines 8-9),

constructing a coding algorithm from the at one selected tool and coding the image data (claim 22 of instant application, lines 5-7), which is same as storing a coding algorithm for coding the image and multiple tools constituting a

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algorithm ( U.S Patent 6,310,981, claim 4, lines 2-3, it is obvious that coding algorithm is constructed from tools constituting coding algorithm);

transmitting coded image data and tool information indicating the decoding algorithm for decoding the coded image data (claim 22 of instant application, lines 7-9) which is same as outputting coded image along with information indicating ranks of tools constituting decoding algorithm (U.S. Patent No. 6,310,981, lines 9-10, image data is obviously transmitted to output device from input device)

U.S. Patent No. 6,310,981 shows selecting multiple tools (U.S. Patent No. 6,310,981, claim 5, lines 9-10). U.S. Patent No. 6,310,981 however have not shown individually selecting at least one tool from the stored tools.

In the same field of endeavor Yagizawa discloses individually selecting at least one tool from the stored tools (Yagizawa in page 5, lines 9-10 and page 5, lines 27-28, states "A coding algorithm storage means configured with multiple RAMS for storing coding table containing coding algorithm for DPCM" and "DPCM table is loaded, can be selected by switching a switch" which corresponds to individually selecting at least one tool from the stored tools).

### **Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Yagizawa et al. (JP Kokai Patent Application No. Hei 4 [1992]-8064).

Regarding claim 20, Yagizawa discloses storing coding algorithm for coding image data and the tools constituting the algorithm (Yagizawa in page 4, lines 7-8, states "multiple decoding algorithm storage and storing coding algorithms" and in page 4, lines 13-14, coding algorithm storage means are multiple RAMS for storing DPCM tables which corresponds to storing coding algorithm for coding image data and the tools constituting the algorithm);

inputting the image data and coding the image data using the stored coding algorithm (Yagizawa in page 5, lines 22-23, states "the DPCM table [coding algorithm for DPCM mentioned above] is loaded first is for the image data that is transmitted first" which corresponds to inputting the image data and coding the image data using the stored coding algorithm).

an output device for outputting coded image data and tool information indicating the decoding algorithm for decoding the coded image data (Yagizawa in page 4, lines 15-20, states "the information transmission means is a means for dividing a required decoding table corresponding to the coding table into separate sync blocks and further adding an identification code before transmission to decoder" corresponds to outputting coded image data and tool information indicating the decoding algorithm for decoding the coded image data),



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at least one tool for constituting the decoding algorithm is selected individually (Yagizawa in page 6, lines 20-22, states "instead of transmitting decoding table from storage device, a counter may be added in order to transmit the decoding table by switching RAM addresses that point to coding table to the counter" corresponds at least one tool [table] for constituting the decoding algorithm [decoding table] is selected individually );

### **Allowable Subject Matter**

6. Claim 21 is objected is being dependent on rejected base claim but would be allowable if rewritten in independent form including limitations of the base claim and any intervening claims.

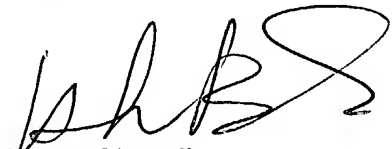
### **Contact Information**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherali Ishrat whose telephone number is 703-308-9589. The examiner can normally be reached on 8:00 AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

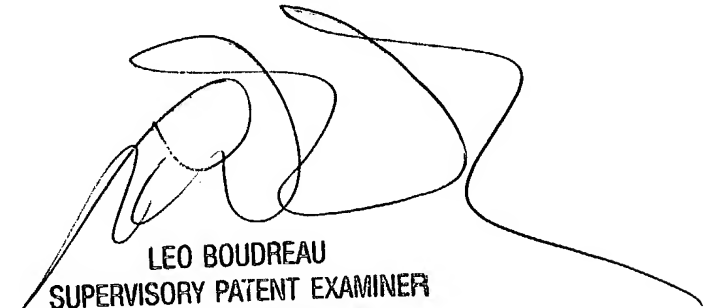


Ishrat Sherali

Patent Examiner

Group Art Unit 2621

September 2, 2004



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